

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY R. LIND

Appeal No. 2000-1315
Application 09/152,563

ON BRIEF

Before PATE, MCQUADE, and GONZALES, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jeffrey R. Lind appeals from the final rejection of claims 1 through 7, 9, 10 and 12 through 30, all of the claims pending in the application. We affirm-in-part and enter a new rejection pursuant to 37 CFR § 1.196(b).

THE INVENTION

The invention involves a replaceable tip for a bowling shoe which provides a desired slide/traction characteristic and protects the shoe from undue wear. A copy of the appealed

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claims appears in the appendix to the appellant's main brief
(Paper No. 11).

THE EVIDENCE

The items relied on by the examiner as evidence of
obviousness are:

McCord 1962	3,027,661	Apr. 3,
Ludwig 1971	3,561,140	Feb. 9,
Guarrera 1972	3,693,269	Sep. 26,
Gillet 1975	3,903,620	Sep. 9,
Bauer 1981	4,267,650	May 19,
Famolare 1996	5,542,198	Aug. 6,
Leclercq 1918 French Patent Document ¹	488,133	Sep. 5,
Trentin 1955 Italian Patent Document ¹	526,565	May 18,

The item relied on by the appellant as evidence of non-
obviousness is:

¹ An English language translation of this reference,
prepared by the United States Patent and Trademark Office, is
appended hereto.

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The 37 CFR § 1.132 Affidavit of Mike Aulby filed September 15, 1999 (Paper No. 7).

THE REJECTIONS

Claims 1 through 4, 6, 9, 10, 12, 13, 16 through 19, 21, 23 through 25, 27, 29 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Famolare in view of Bauer.

Claims 5, 14, 20 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Famolare in view of Bauer, Ludwig, Gillet and Guarrera.

Claims 7, 15, 22 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Famolare in view of Bauer, McCord, Leclercq and Trentin.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 11 and 13) and to the examiner's answer (Paper No. 12) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.²

² In the final rejection (Paper No. 6), the examiner applied Ludwig, Gillet, and Guarrera in the rejection of claims 5, 14, 20 and 26, and McCord, Leclercq and Trentin in the rejection of claims 7, 15, 22 and 28, alternatively as well as cumulatively. In order to reduce the issues on appeal, the examiner has withdrawn the alternative application

DISCUSSION

Famolare, the examiner's primary reference, discloses "a bowling shoe construction having a removable slide pad and heel for varying the friction of the bowling shoe sole on the bowling surface" (column 1, lines 8 through 11). As described in the reference,

[t]he instant bowling shoe construction [10] comprises a shoe upper [12], and a shoe sole [14] mounted to the shoe upper. The shoe sole has a tread surface [24], and a slide area [26] on the tread surface extending longitudinally from a toe end [18] of the shoe sole rearwardly to an arch portion [20] thereof, and extending laterally across the entire width of the tread surface. The bowling shoe construction further comprises a removable slide pad [16] having a peripheral margin equal to the peripheral margin of the slide area on the tread surface so that the slide pad completely overlays the slide area. The slide pad is removably secured to the tread surface by means of interlocking hook and pile fastener materials [32, 34] attached to the slide area of the tread surface and to the slide pad. In a second embodiment, the shoe construction [38] includes a removable slide pad [44] and a removable heel [46] which are removably secured to the sole [42] of the shoe with hook and pile fastener material [50, 52, 58, 60]. The removable slide pad and heel enable the bowler to select slide materials having desired frictional characteristics to improve sliding on varying bowling lane surface conditions [column 1, line 55, through column 2, line 6].

of these references (see page 2 in the answer).

Famolare also teaches that the slide pad can be chosen from a plurality of interchangeable slide pads to vary the friction of the shoe sole (see column 2, lines 46 and 47), and that the foregoing bowling shoe construction can be applied to both shoes of a pair (see column 3, lines 53 through 56).

Famolare does not respond to the various limitations in independent claims 1, 17 and 23 requiring a bowling shoe tip adapted to cover and conform to at least a portion of the adjacent shoe upper. In this regard, claim 1 recites a "bowling shoe with a replaceable bowling shoe tip" comprising, inter alia, a tip "covering and conforming to at least a portion of a toe end of the shoe upper," claim 17 recites a "replaceable bowling shoe tip for a bowling shoe" wherein the tip is "designed and adapted to cover and conform to at least a portion of the adjacent shoe upper," and claim 23 recites a "method of providing a selectable traction surface for a bowling shoe" comprising, inter alia, the step of providing a plurality of bowling shoe tips, each "designed and adapted to cover and conform to at least a portion of the adjacent shoe upper." The appellant's specification (see, for example, pages 1, 2, 6

and 10) indicates that such a tip protects the toe portion of the upper against wear. In contrast, Famolare's bowling shoe tips (replaceable slide pads 16 and 44) extend along the bottom of the shoe sole and do not cover or conform to any part of the shoe upper. The examiner's reliance on Bauer to overcome this deficiency is not well founded.

Bauer discloses an athletic shoe set composed of a pair of uppers 10, each associated with a plurality of replaceable outsoles 26 having different treads suited to particular field surfaces and conditions. Each outsole includes an upstanding marginal strip 32 extending completely about its periphery for covering and interlocking with the lower part of the associated upper.

In proposing to combine Famolare and Bauer to reject claims 1, 17 and 23, the examiner concludes that it would have been obvious "to provide the removable tip [i.e., slide pad 16 or 44] of the bowling shoe of FAMOLARE with a[n] upwardly extending flange and rim, as taught by Bauer, to further secure or lock the shoe and the removable section together" (answer, page 4). As persuasively argued by the appellant,

however, there is nothing in the combined teachings of these references which would have suggested this particular combination. Although Famolare's slide pads and Bauer's outsoles have some characteristics in common (e.g., both are replaceable ground-contacting elements), in an overall sense they are quite distinctive in structure and function. Famolare's slide pad is not an outsole as in Bauer, but is merely an accessory attachable to an outsole. In addition, there is no indication in the prior art that this slide pad needs any additional securement to its sole, much less the level of securement furnished by an upstanding rim or strip of the sort disclosed by Bauer. Moreover, neither of these references contemplates the wear reducing benefits afforded by the appellant's tip. In this light, it is evident that the only suggestion for selectively picking the upstanding rim from Bauer's outsole construction and applying it to Famolare's sliding pads stems from hindsight knowledge impermissibly derived from the appellant's disclosure. Hence, Famolare and Bauer fall short of establishing a prima facie case of

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obviousness with respect to the subject matter recited in claims 1, 17 and 23.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 17 and 23, or of claims 2 through 4, 6, 9, 18, 19, 21, 24, 25, 27, 29 and 30 which variously depend therefrom, as being unpatentable over Famolare in view of Bauer.³

Inasmuch as the examiner' application of Ludwig, Gillet, Guarrera, McCord, Leclercq and Trentin does not cure the above noted failings of the basic Famolare-Bauer combination with respect to parent claims 1, 17 and 23, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 5, 20 and 26 as being unpatentable over Famolare in view of Bauer, Ludwig, Gillet and Guarrera, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 7, 22 and 28 as being unpatentable over Famolare in view of Bauer, McCord, Leclercq and Trentin.

³ Upon return of the application to the technology center, the examiner should reconsider the relevance of U.S. Patent No. 2,325,741 to Chertok, which is of record, to the subject matter recited in claim 17 and the claims depending therefrom.

Independent claim 10 differs from independent claims 1, 17 and 23 in that it recites a "bowling shoe for retaining a replaceable bowling shoe tip" which does not include the tip as part of the claimed shoe. As defined in this claim, the shoe comprises three elements: a bowling shoe upper, a bowling shoe sole having a selectable traction area and a permanent sole area, and means as part of the selectable traction area for removably securing a selected bowling shoe tip thereto and to the shoe upper. These elements find full response in Famolare's bowling shoe upper 12, bowling shoe sole 14 having slide area 26, and hook or pile fastener material 32, respectively. The functional language in the claim relating to the bowling shoe tip merely defines the claimed shoe in terms of its intended use. Since Famolare's shoe is inherently capable of such use, it meets these functional limitations.

Thus, the subject matter recited in claim 10 is anticipated by Famolare.⁴ Since anticipation is the ultimate

⁴ Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

or epitome of obviousness and is not rebuttable by the evidence of non-obviousness (see In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982)), we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 10 as being unpatentable over Famolare in view of Bauer.

Claim 16 recites "[a] pair of bowling shoes, each of which is a shoe according to claim 10." Famolare's disclosure (see column 3, lines 53 through 56) of a pair of bowling shoes having the construction discussed above fully meets these limitations. Therefore, as was the case with claim 10, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 16 as being unpatentable over Famolare in view of Bauer.

Claim 15 depends from claim 10 and requires the selectable traction area to be of reduced thickness compared to a permanent shoe sole area. Although Famolare's selectable traction area (slide area 26) does not meet this limitation, McCord, Leclercq and Trentin demonstrate that this type of expedient is conventional for accommodating removable or replaceable sole components while maintaining a co-planar or flush ground-contacting surface. This self-evident advantage would have provided the artisan with ample suggestion to

provide Famolare's selectable traction area with a reduced thickness as recited in claim 15. The Aulby affidavit is entitled to little, if any, probative value as evidence of non-obviousness here since the benefits alleged in the affidavit are afforded by a bowling shoe tip which is not part of the shoe recited in claim 15.

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 15 as being unpatentable over Famolare in view of Bauer, McCord, Leclercq and Trentin.

We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejection of claims 12 and 13, which depend from claim 10, as being unpatentable over Famolare in view of Bauer, or the standing 35 U.S.C. § 103(a) rejection of claim 14, which depends from claim 10, as being unpatentable over Famolare in view of Bauer, Ludwig, Gillet and Guarrera. For the reasons expressed below, the scope of these claims is unclear. As a consequence, the standing prior art rejections thereof must fall because they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in

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this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

The following new rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 12 through 14 and 18 through 20 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). The purpose of this requirement is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and

dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

The scope of claims 12 through 14 is unclear because the limitations therein requiring the "means for removably securing" to include structure in or on the bowling shoe tip are inconsistent with (1) the recitation in parent claim 10 that such means are part of the selectable traction area of the sole and (2) the fact that the tip is not recited in these claims as part of the claimed shoe.

The scope of claims 18 through 20 is unclear because the term "the means for removably securing" therein lacks a proper antecedent basis (parent claim 17 recites instead "means removably securable"), and because "the means for removably securing" as defined in claims 19 and 20 to include structure attached to the selectable traction area of the sole is inconsistent with the fact that the shoe and its sole are not recited in these claims as part of the claimed tip.

SUMMARY

The decision of the examiner to reject claims 1 through 7, 9, 10 and 12 through 30 is affirmed with respect to claims 10, 15 and 16, and reversed with respect to claims 1 through

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7, 9, 12 through 14 and 17 through 30; and a new rejection of claims 12 through 14 and 18 through 20 is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to

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the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED-IN-PART; 37 CFR § 1.196(b).

WILLIAM F. PATE, III)	
Administrative Patent Judge)	
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